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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,470	05/11/2001	Rolf Castor	GR 98 P 3368 D	6677
24131	7590	09/30/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			MAYEKAR, KISHOR	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,470

Applicant(s)

CASTOR ET AL.

Examiner

Kishor Mayekar

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/320,045.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, the phrase "catalytically reducing" needs to be replaced with the phrase --configured to catalytically reduce-- to eliminate reference to a method of operating the device.

In claim 7, the phrase "said converter" lacks antecedent basis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/03746, a reference cited by Applicant. WO '746's invention is directed to a device for the plasma-chemical decomposition and/or destruction of harmful substances. WO '746 discloses in the abstract and in Figs. 2-10 that the device comprises all the structures as claimed. The differences between WO '746 and the instant claims are the intended use of the device and the manner of operating the device.

As to the former, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings because it has been held on the intended use of a device that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

As to the latter, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have

modified the reference's teachings because the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus itself. *Ex parte Wikdahl* 10 USPQ 2d 1546 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889 (BPAI 1988); *In re Finterswalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235 (CCPA 1967).

5. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over BALOW et al. (5,914,015). BARLOW's invention is directed to a device for processing exhaust gas with corona discharge. BARLOW discloses in Fig. 2 and col. 2, lines 40-45 that the device comprises all the structures as claimed. The difference between WO '746 and the instant claims is the intended use of the device. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings because it has been held on the intended use of a device that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

6. Claim 3-5, 7 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over either WO '746 or BARLOW '015 as applied to claims 1 and 9 above, and further in view of WILLIAMSON et al. (5,843,383). The difference between each of the references applied above and the instant claims are the provisions of a converter, a test probe and a control unit in the device. WILLIAMSON shows in a device for the treatment of exhaust gas by corona discharge that the corona reactor can be used to supplement a conventional catalytic converter (col. 3, lines 22-29), the provision of a sensor in the exhaust gas streams (col. 8, lines 8-14) and the feedback mechanism (last paragraph of col. 4). As such, it has been held that the motivation to make a specific structure is always related to the properties or uses one skilled in the art would expect the structure to have, *In re Newell* 13 USPQ 2d 1248, *Fromson v. Advance Offset Plate* 225 USPQ 26; *In re Gyurik* 201 USPQ 552. The same is applied to the provision of a heat-exchanger as claimed in claim 4.

As to the subject matter of claim 5, making elements integral was held to have been obvious, *In re Wolfe* 116 USPQ 443.

Allowable Subject Matter

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Because the prior art references do not disclose in an apparatus for plasma-chemical production of nitrogen monoxide the provision of the discharge gap having a width in each of the discharge zones increased from discharge zone to discharge zone in the flow direction of the process gas in combination with all the recited structures of claim 1 as claimed in claim 2.

9. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


10. The following is a statement of reasons for the indication of allowable subject matter: Because the prior art references do not disclose in an apparatus for plasma-chemical production of nitrogen monoxide the provision of the recited

branch line in combination with other recited structures of claim 3 as claimed in claim 6.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kishor Mayekar
Primary Examiner
Art Unit 1753